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EXAMINER

RANGREJ, SHEETAL

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Prosecution History Summary

- Claims 1, 10-11, and 27 are cancelled.
- Claims 24-26 and 28-30 are amended.
- Claims 2-9, 12-26 and 28-30 are pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 24, 2-9, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée (<http://web.archive.org/web/200102025005600/careentree.com>, 2001) in view of Lipton, et al. ("Pharmacy benefit management companies: Dimensions of performance", Annual Review of Public Health. Palo Alto: 1999. Vol. 20, p. 361), further in view of Goch ("A New Card Deal." Best's Review. Oldwick: July 2002. Vol. 103 (3); p. 73).

3. As per claim 24, the Care Entrée program teaches a method for receiving a membership fee from one or more individuals to become members of the health care plan (p. 3, para. 10) and participate via incentives within a member multi-level marketing network, wherein one of the incentives includes paying a portion of each received membership fee into a multi-level marketing matrix (p. 2, para. 8-9; p. 11, para. 61-64). The Care Entrée program also teaches obtaining information from one or more medical service/good providers that have joined the

health care plan (p. 8, para. 41) and providing a discount price list stored on the one or more storage devices and the medical service/good provider listing to the member via a communications interface communicably coupled to the server, wherein the discount price list comprises published rates for the services/goods provided by each medical service/good provider within two or more geographic areas and each member can only access the published rates for the geographic area associated with the member and the discount price list (p. 8, para. 41).

The Care Entrée program does not teach a method that regulates the cost of services/goods provided to the members by the medical service/good providers and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers.

Lipton et al. teaches a system comprising a method that regulates the cost of services/goods provided to the members by the medical service/good providers (para. 30) and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers (para. 7, 41-45, and 111).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of the Care Entrée program with Lipton et al. with the motivation of managing medical costs and services (para. 32-34). This is accomplished by a pharmacy manager via drug enrollments reports/physician prescription history and rebates from the drug manufacturer. This can be equated to a network provider in that the network provider takes the information and generates data pertaining to which medical services are most frequently prescribed or ordered, and uses this information to negotiate a discount on that particular service and/or medication.

Lipton fails to explicitly teach a method such that the members pay the medical service/good providers at the time the services/goods rendered to the members based on the discount price list.

Goch teaches a method such that the members pay the medical service/good providers at the time the services/goods rendered to the members based on the discount price list (para. 20); discloses that members pay the published rate on the discount price list for the services/goods rendered by the medical service/good provider in full directly to the medical service/good providers at the time the services/goods rendered to the members based on the discount price list (para. 20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Care Entrée program with Lipton et al. and Goch with the motivation of ensuring a discounted cost for medical services (Goch: para. 18).

4. As per claim 2, the Care Entrée program fails to teach a method wherein the discount price list is a variable discount price list that tracks a known standard service/good price list.

Lipton et al. teaches a system in which the discount price list is a variable discount price list that tracks a known standard service price list (paragraph 7). This is accomplished through the use of negotiated discounts with pharmacy networks, as well as controlling the formularies used by the pharmacy benefit manager (i.e. the pharmacy benefit manager chooses which drugs to include in the formulary, thereby lowering the cost of the pharmaceuticals). This same method can be applied to a list of services provided by a medical provider, wherein negotiated discounts are applied to medical providers, hospitals, hearing, vision, etc. It can be assumed that lists are

required to provide network provider with the recent price list, as well as the discounted price list.

The motivation to combine the teachings is discussed in claim 24.

5. As per claim 3, the Care Entrée program teaches a method wherein the membership fee is paid by the individual (p. 3, para. 10). The Care Entrée program discloses a method in which anyone can pay a certain fee to join a health care plan.

6. As per claim 4, the Care Entrée program teaches a method in which the membership fee is paid by the individual's employer (page 12, paragraph 67).

7. As per claim 5, the Care Entrée program teaches a method in which the membership fee is paid by the individual's business (page 12, paragraph 67). The examiner interprets an individual's employer, in this case, to be equivalent to an individual's business. In either case, the individual is provided the opportunity to offer employees (including self) a supplemental health care plan.

8. As per claim 6, the Care Entrée program teaches a method wherein the member ship fee is a renewal fee (page 2, paragraph 6). The examiner interprets the monthly fee to be a renewal fee - the member is paying a renewal fee every month.

9. As per claim 7, the Care Entrée program teaches a method wherein the member can include his/her family in the health care plan (page 3, paragraph 10). The Care Entrée program allows the entire family (including all Internal Revenue Service dependents) to join the health care plan.

10. As per claim 8, the Care Entrée program teaches a method wherein the medical service/good providers are selected from the group consisting of physicians, hospitals, physical

therapists, nursing facilities, cancer treatment centers, optical and hearing aid dispensaries, hospices, clinics, pharmacies, chiropractors, dentists, medical supply stores, hospital supply stores, and handicap equipment suppliers (page 11, paragraphs 61 - 63). Although physical therapy, cancer treatment centers, and medical, hospital, and handicap supply stores are not specifically taught in the Care Entrée program, these services/providers can be included as ancillary services, as taught by the Care Entrée program (page 5, paragraphs 21 -23).

11. As per claim 9, the Care Entrée program teaches a method wherein the medical service/good provider is a doctor that works for a corporation (page 4, paragraph 16). The Care Entrée program refers to this as a PHCS (Private Health Care System).

12. Claim 28 recite substantially similar limitations as those already addressed in claim 24, and, as such, are rejected for similar reasons as given above.

13. Claims 12-23, 25-26 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée in view of Lipton, et al. and Goch as applied to claim 24 above, and further in view of U.S. Patent No. 5, 819, 092 (Ferguson, et al.).

14. As per claim 12, the method of claim 11 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the basic listings are free of charge to medical services/good providers.

Ferguson et al. teaches a method wherein the basic listings are provided to medical service/good providers free of charge (column 13, lines 66 - 67 through column 14, lines 1 - 12).

The examiner interprets the look up directory disclosed by Ferguson et al. to include a 'basic' listing - where a name, address and other related information is available.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of basic and premium listings as taught by Ferguson et al, with the motivation of providing a fast method of online searching directories (column 4, lines 18 - 20 and 41 - 43).

15. As per claim 13, the method of claim 11 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the premium listings are available to medical service/good providers for a fee.

Ferguson et al. teaches a method wherein the premium listings are provided to medical service/good providers upon payment of a premium listing fee (column 14, lines 6 - 12 and column 18, lines 33- 35). The examiner interprets the look up directory disclosed by Ferguson et al. to include a 'premium' listing - where a name, address and a hyperlinked document with other related information is available.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 12.

16. As per claims 14, 15, and 16 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the premium listings are hyperlinked to a medical service/good providers web page.

Ferguson et al. teaches a method wherein the premium listings include a link to a customizable web page for the medical services/goods provider accessible via a global telecommunications network, wherein the premium listings include a link to the medical service/good provider's web site, and wherein the premium listings are customized for each medical Sservice/good provider (column 14, lines 6 - 19 and column 7, lines 37 - 42). The hyperlinks allow the user to access a site in which qualified users may submit new entries, thereby making it customizable.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of premium listings hyperlinked to a medical service/good providers web page (where the medical service/good provider can be equated to a pharmaceutical company) and is accessible to the global internet as taught by Ferguson et al. with the motivation of allowing a user to create online services using existing information (column 7, lines 1 -4).

17. As per claim 17, the method of claim 10 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the discount price list is available via a telecommunications network.

Ferguson et al. teaches a method wherein the discount price list and the medical service/good providers listing are accessible via a global telecommunications network (column 14, lines 2 - 6 and column 7, lines 37 - 42). The examiner interprets the discount price list to be a function of the directory look up disclosed by Ferguson et al. It provides information to users of a health care plan.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claims 14, 15, and 16.

18. As per claim 18, the method of claim 10 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the discount price list is searchable by members of the health care plan.

Ferguson et al. teaches a method wherein the discount price list and the medical service/goods providers listing are searchable by the members using one or more search criteria (column 10, lines 62-65). Ferguson et al. discloses a method where users are allowed to perform searches, where they can specify the search criteria.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of searching a discount price list and medical service/goods providers listings as taught by Ferguson et al. with the motivation of enabling users to search listings or entries in a directory by a variety of techniques (column 14, lines 10-12), including names, categories, and full text searches.

19. As per claims 19 and 20, the Care Entrée program teaches a method wherein one of the search criteria is based on geographic area and one of the search criteria is based on the services provided by the medical service/good provider (page 12, paragraphs 68 and 69). The Care Entrée program provides a listing of common health care providers in certain area.

20. As per claim 21, the Care Entrée program in view of Lipton et al. teaches the method of claim 1.

The Care Entrée program and Lipton et al. fail to explicitly teach a method wherein the network provider provides the advertisements to members.

Ferguson et al. teaches a method comprising one or more advertisements by the network provider to the members (column 14, lines 6 - 12 and column 14, lines 21 - 31).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of placing online advertisements as taught by Ferguson et al. with the motivation of increasing the sales of a medical services/goods provider by use of advertisements in the discount price list by the network provider (column 9, lines 54 - 56). An online service can be used as a tool to enable electronic commerce. In this case, the online service would advertise services of medical professionals, hospitals and more.

21. As per claim 22, the method of claim 21 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the advertiser pays the network provider a fee for advertising.

Ferguson et al. teaches a method wherein an advertiser pays the network provider an advertising fee to provide the advertisements to the members (column 18, lines 33 - 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of charging a fee to place advertisements as taught by Ferguson et al. with the motivation of creating an easy to use online service (column 10, lines 25 - 29) which can be used to generate revenue for a network provider by allowing a medical service/good provider to advertise on medical services/goods provider lists.

22. As per claim 23, the method of claim 21 as applied to claim 24, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a method wherein the advertisement is used to search the medical service/good provider listing.

Ferguson et al. teaches a method wherein the advertisement provided to a member is based on one or more search criteria used to search the medical service/good provider listing (column 14, lines 6 - 12). Searches can be made in directory look up's using names, categories or full text search techniques.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of including advertisements when conducting a search of a medical service/good provider listing as taught by Ferguson et al. with the motivation of introducing a revenue generating tool by charging a fee for the online service (column 14, lines 30- 31).

23. As per claim 25, the Care Entrée program teaches receiving membership fees from individuals and participating via incentives within a member multi-level marketing network (para. 10), wherein one of the incentives includes paying a portion of each received membership fee into a multi-level marketing matrix (p. 2, para. 8-9; p. 11, para. 61-64), and obtaining information from one or more medical/service good providers that have joined the health care plan (para. 41).

Care Entrée fails to teach a computer program embodied on a computer readable medium executable by a server for providing health care plan comprising: a code segment for providing a discount price list and a medical/service/good provider listing to the members that regulates the

cost of goods/services to members by the medical service/good providers such that the members pay the service/good providers in-full directly for any services/goods rendered to the members based on the discount price list, and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers.

Lipton teaches a discount price list and a medical/service/good provider listing to the members that regulates the cost of goods/services to members by the medical service/good providers such that the members pay the service/good providers in-full directly for any services/goods rendered to the members based on the discount price list, and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers (Lipton: para. 7, 41-45, and 111).

Lipton fails to teach a computer program embodied on a computer readable medium executable by a server and a code segment.

Ferguson teaches a computer program embodied on a computer readable medium (Ferguson: col. 3, 39-50) executable by a server (Ferguson: col. 7, 42-47) and a code segment (Ferguson: col. 2, 39-50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention to combine the teachings of Care Entrée, Lipton, and Ferguson with the motivation of generating and executing a fast, user-friendly online system (Ferguson: col. 4, 18-20).

Applicant has amended claim 25, by adding the limitations already addressed in claim 24; therefore, the rejections applied in claim 24 is also applicable here.

24. As per claim 26, the Care Entrée program teaches a system in which individuals pay a membership fee to the network provider to join the health care plan (page 3, paragraph 10) and

participate via incentives within a member multi-level marketing network (page 2, paragraph 9), wherein one of the incentives includes paying a portion of each received membership fee into a multi-level marketing matrix (p. 2, para. 8-9; p. 11, para. 61-64). The Care Entrée program discloses a method in which anyone can pay a certain fee to join a health care plan.

The Care Entrée program fails to disclose an apparatus for providing a health care plan including a server, storage devices, communication interface, and a membership fee.

Lipton teaches a discount price list and a medical/service/good provider listing to the members that regulates the cost of goods/services to members by the medical service/good providers such that the members pay the service/good providers in-full directly for any services/goods rendered to the members based on the discount price list, and wherein the medical service/good provider listing comprises basic listing and premium listings for the medical service/good providers (Lipton: para. 7, 41-45, and 111).

Ferguson et al. teaches a system for providing a health care plan comprising a server (column 7, lines 42 - 47); one or more storage devices communicable coupled to the server, the one or more storage devices containing a discount price list that regulates the cost of goods/services provided to the members by a health care plan such that the members pay the network provider for any goods and/or services provided in full directly the discount price (column 7, lines 64 - 66); and a communications interface communicably coupled to the server that allows a member to access the discount price list (column 7, lines 48 - 50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention to combine the teachings of Care Entrée, Lipton, and Ferguson with the motivation

of increasing accessibility and availability of the pharmaceutical listing and discount price list (Ferguson: col. 2, 7-9).

Applicant has amended claim 26, by adding the limitations already addressed in claim 24; therefore, the rejections applied in claim 24 is also applicable here.

25. Claim 29 recites substantially similar limitations as those already addressed in claim 25, and, as such, are rejected for similar reasons as given above.

26. Claim 30 recites substantially similar limitations as those already addressed in claim 26, and, as such, are rejected for similar reasons as given above.

Response to Arguments

27. Applicant's arguments with respect to claims 2-26 and 28-30 have been considered but are not persuasive.

28. Applicant submits that the cited references do not teach or suggest that that "one of the incentives comprises paying a portion of each received membership fee into a multi-level marketing matrix". Examiner disagrees. Examiner states that the cited references teaches that the fees paid by the members are paid to the network providers or the doctors (i.e. multi-level marketing matrix); therefore teaching "one of the incentives comprises paying a portion of each received membership fee into a multi-level marketing matrix".

Examiner further states CareEntrée teaches that the providers get an immediate payment to the services rendered without the paperwork and restrictions; furthermore CareEntrée program passes the savings on services on to the members (i.e. multi-level marketing).

Examiner further states that even though CareEntrée does not use the specific terms "incentive" and "multi-level marketing matrix," in construing a claim term the Examiner must

give the claim term its plain and ordinary meaning unless the inventor specifically defines a term.

In giving a claim term its plain and ordinary meaning, the Examiner can give the claim its broadest reasonable interpretation. *In re Baker Hughes, Inc.*, 215 F.3D 1297 (Fed. Cir. 2000).

29. Applicant argues that CareEntrée does not teach or suggest “a discount price list comprises published rates for the services/goods provided by each medical service/good provider within two or more geographic areas and each member can only access the published rates for the geographic area associated with the member.” Examiner disagrees. CareEntrée teaches that the prices of services vary from one geographical location to another but provides an example of what discounts they will receive within the program therefore providing a discount price list. Providing the directory of providers in the member’s area is interpreted as that they can access the published rates for the geographic area associated with the member.

30. Applicant argues that Care Entrée and Lipton do not teach or suggest “a discount price list regulating the cost of services/goods provided.” Examiner disagrees. Care Entrée program is a managed health care program which negotiates the cost of medical services or goods provided for individual members who have paid a membership fee, and provides a price list of services specific to a geographical location (Care Entrée: para. 47-48). Lipton, further, discloses a method in which PBM's represent groups (i.e. employers, HMO's). The difference between the Care Entrée and Lipton subject matter is that a PBM in the Care Entrée program collects fees and costs of medical procedures/pharmaceuticals from an individual, whereas Lipton collects from groups or organizations. The Goch reference is an article describing the Care Entrée program, and supports the Care Entrée reference. Since each element (collection of fees and costs of medical procedures/pharmaceuticals) and the function of the PBM are shown in the prior art,

albeit shown as separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function, but in the very combination itself.

31. In response to applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

32. A reference in a field different from that of applicant's endeavor may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole [MPEP 2141.01]. Prior art of record provides common essential elements, even though the prior art applied is not service/good discounts but rather a specific good discount (i.e. prescription discount); furthermore it solves the pertinent problem.

33. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Conclusion

34. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

35. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571) 270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/S. R. R./
Examiner, Art Unit 3686
December 3, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686